

REMARKS

An Office Action was mailed on May 28, 2003 and declared Final. Claims 1-17 are pending in the present application.

Applicant is submitting herewith a Change of Correspondence form. All future correspondence in this matter should be directed to Customer Number 026304. The attorney docket number has also changed to 3182/FBR (031035-87566), and it is respectfully requested that the Examiner update such information in the PALM system.

The Applicant notes acceptance of the drawings the title and thanks the Examiner for withdrawing these objections.

The Examiner has rejected claims 1-4 and 15-17 under 35 USC §103(a) as being unpatentable over US Patent 6,142,873 to Weiss et al. (referred to below as "Weiss") in view of US Patent 4,743,024 to Helm et. al. (referred to below as "Helm"). Further, the Examiner has rejected claims 5-7, 9-12 and 14 under 35 USC §103(a) as being unpatentable over Weiss and Helm as applied to claim 4 and further in view of US Patent No. 5,743,800 to Huard et. al.

In so far as claim 1 is concerned, the Examiner has indicated that Weiss teaches a gaming machine (Figure 1) having a display means (6) and a game control means (64) arranged to control images displayed on the display. The game control means is arranged to play a game wherein one or more random events are caused to be displayed on the display means (i.e. the reels spin) and, if a predefined winning event results, the machine awards a prize (Figure 2). The Examiner further indicates that the gaming machine of Weiss includes a feature of a changing representation of the awarding of the prize (20) and a player operable control device (12), which, upon manipulation by a player, controls an outcome of the representation to determine an amount awarded to the player (Figure 2).

The Examiner concedes that Weiss fails to teach that the prize is dependent on when the player operates the control device.

However, the Examiner alleges that Helm teaches a slot machine with a skill stop feature that gives the player control over what indicia are displayed when the player operates a control device (26 or 28). (Column 5, lines 30-42). The Examiner is of the view that this means that the prize is dependent on when the player operates the control device. The Examiner is further of the view that skill stop games are well known to the art and give the player a feeling of control, plus they are more challenging than simple slot machines which increases player enjoyment.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have the prize be dependent on when the player operates the control device in order to give the player a feeling of control and present a greater challenge than offered by simple slot machines, thus increasing player enjoyment.

For the reasons set forth below, it is respectfully submitted that the Examiner is incorrect in his interpretation of Helm and, consequently, in his conclusion.

As explicitly stated in Helm at column 2, lines 52-55 the "skill spin" feature associated with each drum is used by the player to stop each reel (or drum) in an attempt to stop that reel in a position "displaying a required number". Thus, the "skill stop" feature of Helm has nothing to do with the stopping of a changing representation and the position at which that representation is stopped being representative of the prize awarded to the player.

The "skill stop" feature of Helm is thus not used directly to determine the prize awarded nor, in fact, to determine the prize amount at all. Rather, the "skill stop" feature, as described at column 5, lines 30-42 of Helm, relates only to the use of a measure of skill by the player in an attempt to obtain a required number. If the number required is obtained resulting in the completion of a bingo score card, a fixed, not variable, prize is awarded.

Neither Helm nor Weiss disclose the required claim element "*changing representation of the awarding of a prize*". In neither of these citations is there a need for such an integer. In the case of Weiss, the secondary display is changed in an attempt to improve the player's position. The display is not a changing representation of the awarding of a prize and the player is not required to stop the display in order to control the value of the prize awarded. Rather, in the case of Weiss, if the player wishes to improve his or her position, the player is required to re-activate the display in an attempt to do so. In the case of Helm, as indicated above, the "skill stop"

feature is used by a player in an attempt to obtain a required number to be used in completing a bingo score card. The "skill stop" feature of Helm is not used to stop a changing representation which is representative of a prize to be awarded.

It is important to note that controlling the outcome of a feature is not the same thing as controlling the stopping position of one or more number generating devices, i.e. the reels of Helm. Hence, Helm does not, with respect, teach the use of a "skill stop" feature of a slot machine where the prize is dependent on when the player operates the control device. All that Helm teaches is the use of a "skill stop" feature in an attempt to obtain a required number in playing of a game, more particularly, a bingo game, which may lead to the awarding of a prize. It will readily be appreciated that there is a fundamental difference between these two scenarios.

Claim 1 of the present invention teaches that the feature is only applicable after a prize has already been won. The feature is used by the player in an attempt to obtain the maximum possible prize applicable. How this is achieved is by the claim element of *"the prize, if any, awarded to the player being dependent on when during the changing of the representation, the player operates the control device"*. The claim does not refer to the use of a "skill stop" feature to obtain a required number as taught by Helm. The claim specifically relates only to the determination of the value, if any, of a prize awarded prior to the commencement of the feature.

Therefore, the "skill stop" feature of Helm relates to a totally different application from the use of the control device in claim 1 of the present application.

Helm suffers from the same disadvantage of Weiss as described in the Applicant's earlier response dated March 14, 2003, to which the Examiner is again referred, in that the player can take as long as she or he likes to make a decision about a following spin of the reels without prejudicing the player's chances. Helm does not disclose that the buttons 26 or 28 have to be operated in a particular period of time in order to improve the player's prospects of success. Therefore, there is no pressure on the player, which is unlike the case of the present invention and which enhances the excitement of the present invention in comparison with that of Weiss and/or Helm.

Most importantly, there is no disclosure in the teachings of Helm as to why one of skill in the art would combine it with the teachings of Weiss. As indicated, for the reasons described

above, the use of the "skill stop" feature of Helm would not alter the prize awarded to the player of a machine such as that taught by Weiss and, consequently, would not result in the present invention as claimed. In fact, Helm specifically teaches away from the present invention as claimed by requiring that, where applicable, the "skill stop" feature be operated prior to the determination of whether or not a prize has been awarded. Further, Helm at column 3, lines 51-56 specifies that the instruction panel 33 indicates "the number of tokens to be won when particular arrangements of members are illuminated". It is totally silent as to teaching that the player can alter the number of tokens won when particular arrangements of members are illuminated. Incidentally, it is assumed that the reference to "members" in that paragraph should be "numbers".

As a result, it is respectfully submitted that the rejection of claims 1-4 and 15-17 should be withdrawn, as there is no teaching in either reference to use the Helm teaching in Weiss. As the CAFC stresses for a § 103 rejection to stand, the Examiner is required to show **with evidence** the motivation, suggestion or teaching of the desirability of making the specific combination at issue. That evidence is required to counter the powerful attraction of a hindsight-based obviousness analysis. See, for example, *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). It is respectfully submitted that this involves more than a mere bald assertion that it would be obvious to combine the cited references. With respect, the Examiner has failed to indicate why one of ordinary skill in the art would be motivated to combine the teachings of Weiss and Helm. *In re Lee* requires that the record must state with particularity all the evidence and rationale on which the PTO relies for a rejection and sets out that it is necessary to explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

Under *Lee*, the PTO must state in writing **the evidence** on which it bases its rejection. With respect, the present office action falls short of this requirement.

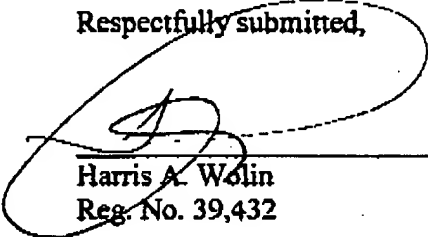
Another reason indicating lack of obviousness is the age between the citations. Weiss is dated November 7, 2000 while Helm has a date some twelve and a half years earlier of May 10, 1988. This, alone, indicates that one of ordinary skill in the art would not have combined the teachings of Helm and Weiss in order to arrive at the present invention as now claimed.

In the circumstances, it is respectfully submitted that the invention as claimed is patentably distinguishable over the art relied on by the Examiner and that the rejection of claims 1-4 and 15-17 under 35 USC §103(a) be withdrawn. As the remaining claims depend from an allowable claim, it is respectfully requested that the rejection of claims 5-7, 9-12 and 14 under 35 USC §103(a) also be withdrawn.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-17, consisting of independent claim 1 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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